

REMARKS

Claims 11-16 are pending in the above-referenced application.

Claims 11-16 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,887,269 to Brunts et al. ("Bruns") in view of U.S. Patent No. 5,774,362 to Suzuki et al. ("Suzuki"). Applicant respectfully submits that the rejection should be withdrawn for the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. Applicant respectfully submits that these criteria for obviousness are not met here.

Independent claim 11 recites, in relevant parts, a navigation card for use with a key card reader of a radio receiver of a navigation system, which navigation card includes "a memory in which at least one navigation destination is stored," and "audio data assigned to the at least one navigation destination stored in the memory."

In support of the final rejection, the Examiner substantially maintains the rationale stated in the previous Office Action of September 14, 2004, i.e., while the Examiner acknowledges that the Brunts reference does not disclose or suggest storing audio data assigned to the at least one navigation destination on the memory card, the Examiner contends that Suzuki teaches "a navigation system for providing route guiding . . . from one location to an inputted destination" (citing col. 4, l. 47-55; col. 5, l. 17-20), and "the memory 25 shown in Figure 1 of Suzuki is considered to store a variety [of] information, including audio data assigned to at least one navigation stored in the memory." (5/5/05 Office Action, p. 5). In essence, the Examiner's contention is that Suzuki teaches the claimed "audio data

assigned to the at least one navigation destination” because Suzuki provides route guiding from one location to an inputted destination. However, the Examiner’s asserted interpretation is clearly contrary to the interpretation that would result if the rules of claim interpretation were properly applied.

With respect to the issue of claim interpretation, Applicants note that even if one applied the Federal Circuit cases most favorable to the Examiner’s position, even if the ordinary and customary meaning of a claim term to persons skilled in the pertinent art is evident, “the inventor’s written description of the invention, for example, is relevant and controlling insofar as it provides clear lexicography or disavowal of the ordinary meaning.” C. R. Bard Inc. v. United States Surgical Corp., 73 U.S.P.Q.2 d 1011, 1014 (Fed. Cir. 2004). This rule is clearly consistent with the long-standing rules that “Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term’s well known usage,” and that the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. MPEP 2111.

When interpreted in light of the above-recited guidelines for claim interpretation, it is quite clear that “audio data assigned to the at least one navigation destination stored in the memory” means audio data describing the characteristics of the navigation destination, i.e., “information relating to points of interest . . . , such as museums, historical city districts and other tourist sights” (Substitute Spec., p. 4, l. 27-28), and the “audio file is invoked and played as soon as the [vehicle] has reached a tourist sight that was previously entered as a navigation destination.” (Substitute Spec., p. 5, l. 13-15). In contrast, the Suzuki reference does not disclose or suggest storing audio data describing the characteristics of the navigation destination; instead, the audio data disclosed by Suzuki merely include audio commands for **route guidance instructions**. (See Suzuki, col. 5, lines 17-20; col. 7, lines 23-25). Nothing in Suzuki suggests storing and/or providing audio data describing the characteristics associated with a specific navigational destination.


Independent of the above, Applicant notes that claim 11 recites that the navigation card includes “a memory in which at least one navigation destination is stored . . . ; and audio data assigned to the at least one navigation destination stored in the memory,” which means the audio data and the at least one navigation destination are both stored on the same navigation card. Neither Brunts nor Suzuki teaches or suggests that the audio data and the at least one navigation destination are both stored on the same navigation card.

For at least these reasons, it is submitted that the combination of Brunts and Suzuki (even if one assumes for the sake of argument that some motivation exists for such a combination, with which assumption Applicant does not agree) does not render obvious the subject matter of independent claim 11 and its dependent claim 12. Since independent claims 13 and 16 recite features analogous to those of independent claim 11, it is submitted that claims 13 and 16, as well as their dependent claims 14 and 15, are likewise allowable over the references relied upon.

CONCLUSION

It is respectfully submitted that all pending claims of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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